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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLAY H. FISHER, STEVEN G. GOLDSTEIN,
and DAVID G. LONGENDYKE

Appeal 2007-2905
Application 09/780,839
Technology Center 2600

Decided: January 17, 2008

Before KENNETH W. HAIRSTON, ANITA PELLMAN GROSS,
and JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

1 Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-4, 6-16, 19-24, 26-36, and 39-42. Claims 5, 17, 18, 25, 37, and 38 have been indicated as containing allowable subject matter (Ans. 2). We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Appellants invented a system for managing content information. Specifically, an electronic image hub device is provided which can include a peripheral device, such as a digital camera. Captured data can then be transferred to a specific data destination.¹ Claim 1 is illustrative:

1. A system for managing content information, comprising:
 - a peripheral device configured to capture said content information; and

an image hub configured to transfer said content information from said peripheral device to a data destination from which a system user selectively accesses said content information, said peripheral device having a transfer capability to transfer said content information only to said image hub.

The Examiner relies on the following prior art references to show unpatentability:

Miller	US 5,949,551	Sep. 7, 1999
Wood	US 6,453,127 B2	Sep. 17, 2002 (filed Sep. 26, 1997)
Strandwitz	US 6,522,352 B1	Feb. 18, 2003 (filed Jun. 22, 1998)
Takahashi	US 6,580,460 B1	Jun. 17, 2003 (filed Feb. 26, 1998)

¹ See generally Spec. 6:12-22.

1. Claims 1, 2, 4, 10-13, 15, 16, 19-22, 24, 30-33, 35, 36, and 39-42 stand rejected under 35 U.S.C. § 102(b)² as being anticipated by Miller.
2. Claims 3 and 23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Miller and Strandwitz.
3. Claims 14 and 34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Miller and Takahashi.
4. Claims 6-9 and 26-29 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Miller, Takahashi, and Wood.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Brief³ and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

The Anticipation Rejection

We first consider the Examiner's rejection of claims 1, 2, 4, 10-13, 15, 16, 19-22, 24, 30-33, 35, 36, and 39-42 under 35 U.S.C. § 102(b) as being anticipated by Miller. Anticipation is established only when a single prior

² Miller actually qualifies as prior art under § 102(e) -- not § 102(b) -- since the patent issued on September 7, 1999 -- a date that is less than one year before the effective filing date of the present application (March 6, 2000). Nevertheless, we consider this error harmless as it does not affect our decision regarding the merits of the anticipation rejection.

³ We refer to the most recent Brief filed Aug. 14, 2006 throughout this opinion.

art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

The Examiner has indicated how the claimed invention is deemed to be fully met by the disclosure of Miller (Ans. 5-8). Regarding representative claim 1,⁴ Appellants argue that since Miller's scanner system may be a digital computer, the reference fails to disclose that the scanner system has a *transfer capability* to transfer image data *only* to the hub station. According to Appellants, it is well known that digital computers can transfer data to many different types of data destinations (App. Br. 8; emphasis in original).

Appellants also argue that Miller teaches transferring only digital images to the image station, but the claim recites transferring "content information." According to Appellants, the Specification defines content information to include a series of descriptors that correspond with a specific captured image (App. Br. 8-9). Appellants emphasize that Miller's scanner system sends an identification signal directly to the printer -- not the hub station 20 -- and that this identification signal is then forwarded to a remote terminal via a route independent of the hub station (App. Br. 9).

The Examiner indicates that Miller transfers "content information" in the form of digital image data from peripheral devices 2A-2N to a data destination 40A-40N through image hub 20 via connections 10, 30.

⁴ Appellants argue claims 1, 2, 4, 11-13, 20-22, 24, 31-33, and 40 together as a group. See App. Br. 7. Accordingly, we select claim 1 as representative. See 37 C.F.R. § 41.37(c)(1)(vii).

According to the Examiner, at any point in time, an exclusive connection is made between (1) one of the peripheral devices, (2) the image hub, and (3) one of the data destinations (Ans. 16-18).

We will sustain the Examiner's rejection of representative claim 1. At the outset, we agree with the Examiner (Ans. 17-18) that the scope and breadth of the term "content information" as claimed does not preclude digital image data in Miller. We do not agree with Appellants that the term was defined in the Specification to require the inclusion of descriptors.

Not only does the Specification repeatedly indicate that content information "may" include descriptors,⁵ the Specification explicitly states that "...in certain embodiments, content information 216 may be implemented *without* utilizing descriptor(s) 412" (Spec. 11:31-12:2; emphasis added). Such statements hardly mandate the inclusion of descriptors in content information as Appellants seem to suggest.

Turning now to the prior art, Miller discloses an image handling system for scanning film images to obtain corresponding digital images. To this end, the system comprises multiple processor-scanner stations 2A-2N which include a film processor and a scanner system 6. The scanner system scans the hardcopy images on each negative set 52 to obtain a corresponding digital image set. The scanner system may be a digital computer in the form

⁵ The Specification states in pertinent part that "...content information 216 preferably *may* include individual sets of data 1 (414(a)) through data N (414(c)) that each preferably corresponds with a specific captured image or other type of stored information. In the FIG. 4 embodiment, content information 216 preferably also *may* include a descriptor 1 (412(a)) through a descriptor N (412(c))....In alternate embodiments, content information 216 *may* be configured to include one or more single descriptors 412 that describe multiple sets of data 414" (Spec. 11:23-31; emphasis added).

of a workstation or desktop computer equipped with a digital scanner (Miller, col. 5, ll. 29-42; col. 6, ll. 24-35; Figs. 1, 2A).

The scanner system 6 generates image signals at different resolutions which are then sent to hub station 20 (Miller, col. 6, ll. 35-61). The hub station 20 includes a communication system to receive image set signals and their associated identification signals from each of the processor-scanner stations (Miller, col. 10, ll. 1-19; Fig. 2B). Hub station 20 also has another communication system for communicating stored image set signals to any of plural terminals 40A-40N connected to the hub station (Miller, col. 10, ll. 30-52).

In one embodiment, the hub station address can be recorded on the film itself. In such a case, the processor-scanner station may be programmed to automatically communicate image signal sets and associated data to the hub station so identified (Miller, col. 16, ll. 6-18; Fig. 4).

This functionality, in our view, clearly teaches that the processor-scanner station has the capability to transfer image signal sets (i.e., “content information”) to a single, dedicated hub station corresponding to the recorded address. Thus, for any given film to be processed, the processor-scanner station has the capability to transfer content information only to the hub station so identified.

That digital computers may be used in the scanner systems of Miller hardly means that they do not have the capability to transfer content information only to an image hub. First, Miller suggests that using digital computers in the scanning system is optional. But even if digital computers are used in Miller’s scanning systems, they would be suitably programmed

to send content information only to the identified hub station in the manner noted above.⁶

Since representative claim 1 is fully met by Miller, we will sustain the Examiner's rejection of that claim. We will also sustain the rejection of claims 2, 4, 10-13, 15, 16, 19-22, 24, 30-33, 35, 36, and 39-42 which fall with claim 1.

Claims 10 and 20

Regarding claims 10 and 20, we agree with the Examiner (Ans. 6 and 18) that Miller's content information can include both (1) digital image data, and (2) a corresponding descriptor in the form of an ID signal. Miller indicates that the hub station receives both the digital image sets and its associated identification signal communicated from the processor-scanner stations (Miller, col. 12, ll. 28-50). Moreover, as indicated above in connection with claim 1, Miller further notes that the processor-scanner station may be programmed to automatically communicate image signal sets and associated data to the hub station so identified (Miller, col. 16, ll. 10-13; emphasis added). Such "associated data," in our view, would reasonably include the ID signals.

For the foregoing reasons, we will sustain the Examiner's rejection of representative claim 10 and claim 20 which falls with claim 10.

⁶ According to Miller, "[h]igh volume scanner system 6 *may* be a digital computer suitably programmed to perform the necessary steps discussed herein, in the form of a workstation or desktop computer..." (Miller, col. 6, ll. 31-34; emphasis added).

Claims 15, 16, 35, and 36

We will also sustain the Examiner's rejection of claims 15, 16, 35, and 36. Although Appellants summarily contend that Miller fails to disclose certain recited limitations including an application program of the image hub to automatically determine one or more image management functions that include a data routing function (App. Br. 10), Appellants have simply not persuasively rebutted the Examiner's *prima facie* case of anticipation.

Significantly, apart from merely contending that Miller fails to disclose the stated limitations, Appellants have not specifically addressed the Examiner's reliance on the cited passages from Miller that are said to teach the capability of the hub station to perform image management functions including the recited data routing function (Ans. 6, 7, 18, 19).⁷ Since we find the Examiner's position reasonable -- and indeed unrebutted -- we will sustain the Examiner's rejection of claims 15, 16, 35, and 36.

Claims 19 and 39

Likewise, we will sustain the Examiner's rejection of claims 19 and 39. As with the previous group of claims, Appellant does not specifically point out or explain the deficiencies regarding the Examiner's reliance on Miller for the recited limitations, but rather merely asserts that the reference fails to disclose these limitations (App. Br. 12).

We find the Examiner's reliance on the hub station's inquiry feature when images are not received (i.e., when valid conditions do not exist) described in column 14, lines 8-67 of Miller reasonably corresponds to the claimed error message. Moreover, Appellants have not persuasively

⁷ Merely pointing out what a claim recites is not considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii).

rebutted the Examiner's position regarding the image hub's execution of image management functions if valid conditions exist (Ans. 20) -- a position that we find reasonable. Since Appellants have not persuasively rebutted the Examiner's *prima facie* case of anticipation for claims 19 and 39, we will sustain the rejection of those claims.

Independent Claim 42

We will also sustain the Examiner's rejection of independent claim 42 which recites limitations in means-plus-function format. Under 35 U.S.C. § 112, sixth paragraph, these limitations are construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. *See In re Donaldson Co., Inc.*, 16 F.3d 1189 (Fed. Cir. 1994).

The Examiner has indicated how each recited means-plus-function limitation is deemed to be fully met by the disclosure of Miller (Ans. 7, 8, 20-22). Apart from merely asserting that there are "substantial differences" between Miller and the disclosed invention (App. Br. 13), Appellants provide no supporting analysis specifically addressing the purported deficiencies of the relied-upon passages in Miller nor do Appellants explain why these passages in Miller fail to anticipate the corresponding structure in the specification or its equivalents.

Since Appellants have not persuasively rebutted the Examiner's *prima facie* case of anticipation – a position that we find reasonable – we will sustain the rejection of independent claim 42.

The Obviousness Rejections

Claims 3 and 23

We now consider the Examiner's rejection of claims 3 and 23 under 35 U.S.C. § 103(a) as unpatentable over Miller and Strandwitz. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Discussing the question of obviousness of a patent that claims a combination of known elements, *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida [v. AG Pro, Inc.*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock[, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740. If the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that “there was an apparent reason to combine the known elements

in the fashion claimed.” *Id.* at 1740-41. Such a showing requires “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

If the Examiner’s burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Regarding claims 3 and 23, we find that the Examiner has established at least a prima facie case of obviousness of those claims that Appellants have not persuasively rebutted. Specifically, the Examiner has (1) pointed out the teachings of Miller, (2) noted the perceived differences between Miller and the claimed invention, and (3) reasonably indicated how and why Miller would have been modified in view of the disclosure of Strandwitz to arrive at the claimed invention (Ans. 9). Once the Examiner has satisfied the burden of presenting a prima facie case of obviousness, the burden then shifts to Appellants to present evidence or arguments that persuasively rebut the Examiner’s prima facie case. Appellants did not persuasively rebut the Examiner’s prima facie case of obviousness, but merely asserted that the cited references do not explicitly suggest a combination that would result in the claimed invention (App. Br. 14). The rejection is therefore sustained.

Claims 14 and 34

Likewise, we will sustain the Examiner's rejection of claims 14 and 34 under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Miller and Takahashi. We find that the Examiner has established at least a prima facie case of obviousness for these claims on pages 9-11 of the Answer which has not been persuasively rebutted. Apart from merely alleging that the references fail to teach or suggest the claimed limitations, Appellants have not specifically pointed out or explained the purported deficiencies in the Examiner's position (App. Br. 16). The Examiner's rejection is therefore sustained.

Claims 6, 7, 9, 26, 27, and 29

We will also sustain the Examiner's rejections of claims 6, 7, 9, 26, 27, and 29. Although Appellants challenged the Examiner's prior use of Official Notice with respect to these claims (App. Br. 18-21), the Examiner has provided evidentiary support for these limitations (Ans. 11-16; 23-28). Accordingly, the Examiner has established a prima facie case of obviousness that Appellants have not persuasively rebutted. The rejection is therefore sustained.

Claims 8 and 28

We will not, however, sustain the Examiner's rejection of claims 8 and 28. The Examiner acknowledges that no image editing occurs at the image hub 20, but rather the image hub receives and stores edited image data sent from the users' remote terminals 40A-N. The Examiner nonetheless takes the position that the *memory* of Miller's image hub corresponds to the

recited “editing module” since it stores the edited image data (Ans. 14 and 27).

We disagree. Although the Examiner is correct in that a user may edit images at a remote terminal and communicate these edited images back to the hub station (Miller, col. 13, ll. 13-31), the recited “editing module” of the image hub, in our view, requires some type of editing functionality. That is, the image hub must be capable of editing the received data in some way to reasonably comprise an “editing module”: mere receipt and storage of previously-edited data is not enough. Since Miller neither teaches nor suggests that the image hub comprises an editing module, we cannot sustain the Examiner’s rejection of claims 8 and 28.

DECISION

We have sustained the Examiner’s rejections with respect to claims 1-4, 6, 7, 9-16, 19-24, 26, 27, 29-36, and 39-42. We have not, however, sustained the Examiner’s rejection of claims 8 and 28. Therefore, the Examiner’s decision rejecting claims 1-4, 6-16, 19-24, 26-36, and 39-42 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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